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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,652	09/29/2004	Andreas Fechtenkoetter	53410	2281

26474 7590 12/02/2005

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EXAMINER

CHOI, LING SIU

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/509,652	Applicant(s) FECHTENKOETTER ET AL.	
	Examiner Ling-Siu Choi	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on the Amendment filed 09/02/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the Reply filed September 2, 2005. Claims 1-9 are now pending, wherein claims 1-4 are drawn to a thixotropic agent; claim 5 a process to prepare the thixotropic agent; claim 6 a coating material; claim 7 a metallic paint; claim 8 a process to prepare the coating material or metallic paint; claim 9 a surface coated with the coating material or metallic paint. In view of the Reply, the claim rejections under 35 USC 103 are moved. Since the following rejections are based on a new ground, the present Office Action is made as a second non-final rejections.

Claim Objections

2. Claims 1-9 are objected to because of the following informalities: c(a) Claim 1, line 17, "at least one solvent" is suggested to be changed to --at least one second solvent--; (b) Claim 3, line 3, "at least one solvent" is suggested to be changed to --at least one second solvent--; and (c) Claim 1, line 10 (Formula 1), R1 and R2 are suggested to be changed to R¹ and R², respectively.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102

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that form the basis for the rejections under this section made in this Office

action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Oeder et al. (US 4, 406,705).

A thixotropic agent comprising			
0.1-30 wt%	ethylene terpolymer wax	80-99 wt% ethylene	
		0.1-20 wt%	C ₃₋₁₂ alkenecarboxylic acid (1-99%)
			CH ₂ =CH[C(=O)(OR ²)] (99-1%)
5-70 wt%	first solvent incompatible with the ethylene terpolymer wax		
5-85 wt%	second solvent compatible with the ethylene terpolymer wax and the first solvent		

(summary of claim 1)

thixotropic - spreading or flowing with stress, but remaining stable in the absence of stress [col. 2, lines 45-47 (US 4,200,561 to Chang)]

Oeder et al. disclose a water-emulsifiable hard wax consisting of homogeneous terpolymer of ethylene, 1-8 wt % of C₃₋₈ olefinically unsaturated carboxylic acid, and 0.5-10 wt % C₁₋₁₂ alkyl ester of the unsaturated carboxylic acid (claim 1). Attention is drawn

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to Example 17, wherein wax granules is emulsified by stirring 20 parts of the terpolymer in [4 parts of a non-ionic emulsifier + 0.72 part of ethylene glycol] and 30 parts of water. It is noted that "water-emulsifiable hard wax" reads on "thixotropic agent". Thus, the present claims are anticipated by the disclosure of Oeder et al.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oeder et al. (US 4,406,705).

Oeder et al. disclose a water-emulsifiable hard wax consisting of homogeneous terpolymer of ethylene, 1-8 wt % of C₃₋₈ olefinically unsaturated carboxylic acid, and 0.5-10 wt % C₁₋₁₂ alkyl ester of the unsaturated carboxylic acid (claim 1). Attention is drawn to Example 17, wherein wax granules is emulsified by stirring 20 parts of the terpolymer in [4 parts of a non-ionic emulsifier + 0.72 part of ethylene glycol] and 30 parts of water.

The difference between the present claims and the disclosure of Oeder et al. is the requirement of the hard wax being applied to coating process.

Oeder et al. also disclose that "when spread on a glass plate, the emulsion

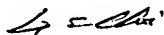
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formed a film at room temperature; the film was clear, glossy, tough, non-tacky and speck-free..."(col. 5, lines 20-24). In addition, the composition disclosed by Oeder et al. is substantially identical to the one of the present claims. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to adapt the composition disclosed by Oeder et al. in the coating process and thereby obtain the present invention.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ling-Siu Choi whose telephone number is 571-272-1098.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reach on 571-272-1114.



**LING-SUI CHOI
PRIMARY EXAMINER**

November 22, 2005